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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of: **Seiichi Yano**

Serial No.: **10/030,149**

Filed: **January 28, 2002**

Group Art Unit: **3629**

Examiner: **Michael J. Fisher**

P.T.O. Confirmation No.: **8179**

For: **VEHICLE RESALE PRICE ANALYSIS SYSTEM**

2nd REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket **020063**

June 23, 2010

Sir:

This paper is timely filed in response to the Examiner's Answer dated April 23, 2010.

*The honorable Board is invited to note that the new Answer of April 23, 2010 is substantially the same as the old Answer of January 11, 2008. The new Answer differs from the old in not rejecting claim 1 under the second paragraph of § 101, and in not rejecting claims 13-19 under the second paragraph of § 102 over Whitworth. The other rejections, and the remarks, appear to be identical. **Therefore, the Reply below is substantially the same as the previous Reply.** Consideration is requested on either Reply.*

The Examiner's remarks (1)-(7) are noted.

The Examiner's remark (8) is not understood. No evidence was submitted with the Brief. Whitworth is applied as prior art and is not believed to be "evidence."

In (9) the rejections are repeated.

The paragraphs spanning pages 2/3 in the Final Action of December 18, 2006, and the following paragraph, are not repeated and therefore withdrawn from the §112, first paragraph rejection.

The paragraph at the bottom of page 3 of the Final Action is not repeated and this portion of the rejection is therefore withdrawn.

In the §103 rejection, the Examiner removes remarks about claims 14-19.

The Appellants reply to the Examiner's remarks in (10) on page 9 of the Answer:

Multi-Regression. The Examiner refers to "an unknown 'multi-regression' formula." With respect, this is unknown to the Examiner but not to those skilled in the art. A Google search on "multi-regression analysis" recently produced 3,450 hits, and the Google patent site turned up 42 US patents containing the phrase "multi-regression," the first being USP 4,485,650. The general term "regression" refers to a well-known statistical technique that has been in use for many decades. The undersigned attorney possesses a statistics textbook, copyrighted in 1962, that has a chapter on regression and correlation.

The Examiner asserts that values to be used in the multi-regression are not delineated. This remark is not germane because regression, like most mathematics, is a *general* technique that can be applied to various different things. The claims include lengthy lists of factors. Anyone who can use the known technique of regression analysis could use it with the very specific factors of the Appellants.

§ 112, First Paragraph. The Examiner asserts that no one would "know how to combine the factors described." However, in view of the well-known nature of multi-regression analysis, the Examiner is respectfully believed to be mistaken.

The phrase "such as," which the Examiner quotes from claim 1, is no longer in that claim.

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§ 112, Second Paragraph. The Examiner repeats the assertion that the "system" claims include only method steps. However, there is no specific rebuttal of the Appellants' arguments, or the table mentioned in the claims and referred by the Appellants.

The Appellants mentioned Fig. 1, but the Examiner has not responded to this mention. The specification at page 21, line 11, states that Fig. 1 shows a "system" and the description refers to it as a "structure" (page 23, 4th line from the bottom). From Fig. 1, which shows a Bid Hall and databases, and from such description as "data stored in the vehicle type database 13 ... is transmitted to the ... analysis system 21" (page 27, line 16), a person skilled in the art would know that the claimed system could easily be embodied using computers, for example, in addition to a Bid Hall and databases.

The term "system" is broad, but breadth is not the same as indefiniteness.

The Examiner's reference to different statutory classes (page 8, line 8) is not relevant because there is no rejection under §101.

Claims 8 and 21. The Examiner asserts that he can pick and choose limitations that are recited in the alternative. However, the limitations in claim 8 are *not* recited in the alternative. In the list of the second paragraph, the word "and" occurs between the next-to-last and last-listed features. (The same is true in claim 21.) The Appellants had argued (Brief of October 15, page 25, second paragraph) that the Examiner cannot pick and choose because *all* of the recited elements must be present in a reference for anticipation. With respect, the Examiner seems to miss the Appellants' point.

Claim 1. The Examiner's remarks in the middle paragraph on page 10 raise a new issue, namely, the assertion that "the appellant is implicitly agreeing that [multi-regression equations]

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are old and well-known and therefore, [claims 1 and 2 are obvious]." The Examiner appears to assert that any claim which recites a known element is obvious, which is not true.

Claim 3. The word "and" at the bottom of page 28 in the Appellants' Brief shows that the argument for claim 3 relates to non-alternative recitations, but the Examiner again asserts anticipation of a single element and argues alternative recitation (page 9, first paragraph of the Answer).

Claim 13. The Examiner's remarks are not understood.

Claims 14-18. None of these claims have alternative recitations of the factors.

Claim 19. The Examiner incorrectly characterizes a statement that specific claimed features are not disclosed by the prior art as a "general allegation."

Official Notice. The Examiner asserts (page 11, line 11), re claim 20, that it is the Applicant's duty to assert that an officially-noticed feature is not old and well known; that the Appellant has never done so; and that the Examiner is therefore under no duty to produce an actual reference. However, the Examiner provides no citation for the asserted requirement of stating that the noticed featured is not old and well-known. Furthermore, the Appellants wrote that "the applicants wish to traverse the Examiner's grounds of rejection" (page 27, 5th line from the bottom in the reply to the Office Action of July 3, 2006), and the grounds were that the feature is old and well-known (assertedly).

Non-Consideration of Arguments. The Examiner states that no consideration is being given to arguments for claims 4-7, 1-12, 22, and 23 because they "were not included in the summary of claimed subject matter."

This non-consideration is completely improper. 37 C.F.R. § 41.37(c)(1)(v) states that a concise explanation is required for "each of the *independent* claims," and for dependent claims

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only an explanation of means-plus-function features is required. Furthermore, 37 C.F.R. §41.37(d) states that when the explanation is deemed inadequate, then a notice of non-compliance should be sent; it does not state that the examiner is given the privilege of ignoring the appellant's arguments.

A Statement Is Requested. The Appellants request a statement from the Examiner that the non-consideration of these claims has been remedied by additional consideration by the Examiner.

For the reasons above, the honorable Board is requested to overturn the rejections.

Respectfully submitted,

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I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571-273-8300) on June 23, 2010.

Nick Bromer (reg. no. 33,478)   *Signature* _Nick Bromer_

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